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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/354,726	12/06/94	SOUDA	S 42327

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FAN, J EXAMINER

ART UNIT PAPER NUMBER

1203

#4  
03/22/95

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ \_\_\_\_\_

Part II SUMMARY OF ACTION

1. ☒ Claims 18-19 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 18-19 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☒ been filed in parent application, serial no. 07/462,328; filed on 12/28/89.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other:

EXAMINER'S ACTION

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This application does not contain an ABSTRACT as required by 37 CFR 1.72 (b). An ABSTRACT on a separate sheet is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

It is noted that many pages in the specification are illegible, such as pages 1-12, 20-24, 26, 30 etc. Applicants are required to submit new pages to correct this objection.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

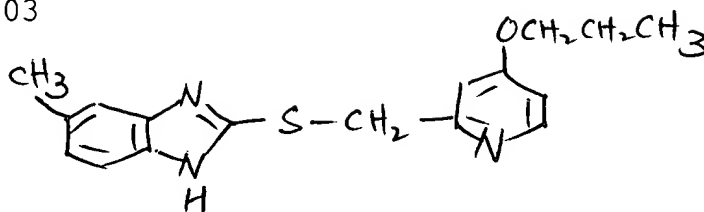
A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 18-19 are rejected under 35 USC 103 as being unpatentable over EP 074,341 alone or in view of EP 198,208.

EP 074,341 at page 20, example 27 teaches the following compound:

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which is a homolog/isomer of the claimed compound used for the same purpose.

The close relationship is such that a presumption of unpatentability arises against a claim directed to a composition of matter, the adjacent homologue/isomer of which is old in the art. The burden is on the applicant to rebut that presumption by a showing that the claimed compound possesses unobvious or unexpected beneficial properties not actually possessed by the prior art homologue. EP 198,208 is cited since it shows the interchangeability of various carbon chain length of alkoxy-alkoxy substituent on 4-position of pyridine ring. Person skilled in the art would be motivated to take compound in EP 074,341 and modify it in view of the teaching of EP 198,208 and come up to the claimed compound for the claimed use.

Claims 18-19 are rejected under 35 U.S.C. § 103 as being unpatentable over GB 2,134,523 by Brandstrom et al. or pat' 905 by Jurggen et al optionally in view of EP 198,208.

The claimed compound is a homolog of the specific example as taught in Junggren et al. ex. 27 and GB 2,134,523 page 16, line 9 from the bottom. The interchangeability between hydrogen and methyl group as substituent on either the pyridine ring or

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imidazole ring is taught in GB reference page 2, lines 33-34 and Jurggren et al.'905 col.2 lines 10-20. The interchangeability of -S- and -S- is taught in GB reference page 1, line 48. The interchangeability of various length of alkoxyalkoxy for the 4-substituent on the pyridine ring is taught in EP 198,208, col. 2 line 24 for the same utility.

Claims 18-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No.5,045,552 in view of GB 2,134,523.

The claimed compound differs from the claimed compound in the parent patent in having sulfur linkage rather than sulfoxide linkage. The secondary reference shows the equivalence of the two rendering the claims obvious. The parent claims were allowed because of the 132 affidavit, however, there is no 132 affidavit herein.

Claims 18-19 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim of copending application Serial No. 07/699,442. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

Claims 18-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim of copending application Serial No.

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07/699,442. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variants of each other.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The structure is not legible.

The status of the parent cases should be updated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE FAN whose telephone number is (703) 308-4705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JTF MARCH 16, 1995

  
JANE FAN  
PRIMARY EXAMINER  
GROUP 1200